

REMARKS

Summary of Office Action

Claims 1, 2, 5-16, 27, 31-39, 41, 43-46, 49, 51-54, 64, 65, 67, 72, 73, 76, 78-85, and 87-99 are pending in this application.

The Examiner finally rejected claims 45, 46, 49, 88-90, and 93-99 under 35 U.S.C. § 102(b) as being anticipated by Marchesi U.S. Patent No. 4,736,494 (hereinafter "Marchesi").

Claims 1, 2, 5-11, 15, 27-36, 39, 41, 43, 45, 46, 49, 51-54, 65, 67, 78-85, 87-90, and 93-99 were finally rejected under 35 U.S.C. § 102(e) as being anticipated by Herrington et al. U.S. Patent No. 6,379,363 (hereinafter "Herrington").

And dependent claims 12-14, 16, 37, 38, 44, 64, 72, 76, 91, and 92 were finally rejected under 35 U.S.C. § 103(a) as being obvious from Herrington.

Rejections of Claims 45, 46, 49, 88-90, and 93-99 Under 35 U.S.C. § 102(b)

Independent claim 45 and dependent claims 46, 49, 88-90, and 93-99 were rejected under 35 U.S.C. § 102(b) as being anticipated by Marchesi.

These rejections are respectfully traversed.

Independent claim 45 requires an extension member to extend from a first clamping member through a through hole in a second clamping member to at least a second surface of the second clamping member that faces away from the first clamping member.

Marchesi has two separate shanks 21, one in the male element 14 and the other in the female element 15. Neither shank 21 extends from one element into a through hole in the

other element, much less to at least a surface of the other element that faces away from the one element.

Plainly, Marchesi does not anticipate amended claim 45.

Independent claim 45 should therefore be allowable and, consequently, dependent claims 46, 49, 88-90, and 93-99, which depend directly or indirectly from claim 45, should also be allowable (i.e., dependent claims are allowable if their independent claim is allowable).

Accordingly, applicants respectfully request that the rejections of claims 45, 46, 49, 88-90, and 93-99 under 35 U.S.C. § 102(b) be withdrawn.

Rejections of Claims Based on Herrington

Claims 1, 2, 5-11, 15, 27-36, 39, 41, 43, 45, 46, 49, 51-54, 65, 67, 78-85, 87-90, and 93-99 were rejected under 35 U.S.C. § 102(e) as being anticipated by Herrington. Claims 12-14, 16, 37, 38, 44, 64, 72, 76, 91, and 92 were rejected under 35 U.S.C. § 103(a) as being obvious from Herrington.

These rejections are respectfully traversed.

Independent claim 1 requires, among other things, a “substantially smooth” extension member.

Independent claims 2, 11, 27, and 45 require, among other things, a “smooth” extension member.

The Examiner said that the words of the claim must be given their plain meaning unless applicants have provided a clear definition in the specification.

Applicants did not define the word “smooth” in the specification, thus the word “smooth” should be given its plain meaning, such as, for example: “having a continuous even

surface,” “causing no resistance to sliding,” and/or “free from lumps” (Merriam-Webster’s Collegiate Dictionary 1109 (10th ed. 1999)).

Applicants’ extension member is smooth so it can be “slidably” received through a hole in a clamping member (*see, e.g.*, applicants’ specification, page 2, lines 17-20; page 3, line 5; and page 6, lines 10-11).

A smooth extension member advantageously allows the second clamping member to easily slide towards the first clamping member. That is, less force is needed to move the second clamping member toward the first than would be needed if the extension member had ridges or ratchet teeth in contact with the second clamping member. This allows a surgeon to apply less force to the clamp, and thus to better control the clamp, during what is typically a delicate surgical procedure. Also, a smooth extension member may be less costly to manufacture than one with teeth or ridges, because such teeth or ridges usually involve additional machining operations.

In contrast, Herrington discloses a stem 16 which is almost completely covered with ridges. In particular, “between the distal end 30 and the cap 14 are a plurality of fine rectangularly-shaped annular ridges 32.... Positioned between the cap 14 and the proximal end 28 are a plurality of coarse arcuately-shaped annular ridges 34,” (column 4, lines 30-36; emphasis added). Herrington’s FIGS. 1 and 2 show fine ridges 32 and coarse ridges 34 covering about 95% of stem 16.

Herrington also discloses that its cap 14 has a plurality of distal tips 58 that form an “engagement region 59 about the stem 16” in a ratchet-type arrangement with the annular ridges (column 4, line 67; *see also* FIG. 3). Applicants’ extension member and clamping member do not engage each other in such an arrangement.

Applicants respectfully submit that Herrington's stem 16 is not in any way "smooth" in accordance with the plain and ordinary meaning of the word "smooth:"

Herrington's stem 16 does not have a continuous even surface (*e.g.*, "ridges 32 are snappingly engaged by the cap 14," column 4, line 32; emphasis added).

Herrington's stem 16 does cause resistance to sliding (*e.g.*, "ridges 34 ... form a textured engagement surface to increase the frictional engagement," column 4, lines 36-39; emphasis added).

And Herrington's stem 16 is not free from lumps (*i.e.*, it has fine and coarse ridges).

Therefore, according to the plain meaning of the word "smooth," Herrington's stem 16 is not "smooth" or even "substantially smooth."

The Examiner also said that because "Applicants have not specified whether the extension member is substantially smooth on a macroscopic or a microscopic scale, Herrington et al. meets the claim limitations" (page 4, July 27, 2007 Final Office Action; emphasis added).

This conclusion is unreasonable. The Examiner has in effect rendered the claim limitation "smooth" totally meaningless.

Moreover, as readily apparent from applicants' FIGS., extension member 16 is at least "macroscopically" smooth, while Herrington's ridged stem 16 is not.

Applicants respectfully submit that a person of ordinary skill in the art who has reviewed applicants' extension member in the FIGS. and specification and Herrington's stem 16 in its FIGS. 1 and 2 and disclosure, and who has noted the functional difference of each (sliding engagement versus ratchet-type engagement), would not conclude that both are "smooth."

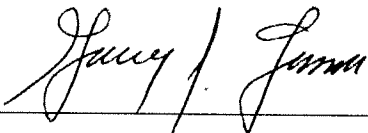
Independent claims 1, 2, 11, 27, and 45 are therefore not anticipated by Herrington and should be allowable. Dependent claims 5-10, 12-16, 28-39, 41, 43, 44, 46, 49, 51-54, 64, 65, 67, 72, 76, 78-85, and 87-99, which depend from one of the independent claims, should also be allowable (i.e., dependent claims are allowable if their independent claim is allowable).

Accordingly, applicants respectfully request that the rejections of claims 1, 2, 5-16, 27-39, 41, 43-46, 49, 51-54, 64, 65, 67, 72, 76, 78-85, and 87-99 under 35 U.S.C. §§ 102(e) and 103(a) be withdrawn.

Conclusion

The foregoing demonstrates that claims 1, 2, 5-16, 27, 31-39, 41, 43-46, 49, 51-54, 64, 65, 67, 72, 73, 76, 78-85, and 87-99 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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